

REMARKS

The following Remarks are submitted in response to the Final Office Action dated July 16, 2003, and respectfully requests that the Examiner reconsider the rejection of the claims as set forth therein.

This Final Rejection is in reply to the applicant's Response Under 37 C.F.R. §1.111 of April 29, 2003 to the First Office Action of January 30, 2003.

In the response of April 29, 2003, the applicant cancelled claims 1-8, 16, 18 and 21-28. Only claims 9-15, 17 and 19-20 remain in the application. The applicant amended claim 12 to be in independent form. Claim 17 was amended to depend from claim 12.

In the instant Final Rejection, the Examiner has rejected claims 12, 9, 13, 14 and 15 under 35 U.S.C. 103(a) as being unpatentable over Prior et al (US 6,349,220 B1 - filed October 27, 1998 - issued Feb. 19, 2002) in view of Moriya (GB 2 328 343 A - issued Feb. 17, 1999) and further in view of Moon et al (US 6,211,858 B1 - filed Sept. 26, 1997 - issued April 3, 2001).

The Examiner has rejected claims 10 and 11 under 35 U.S.C. 103(a) as being unpatentable over Prior et al in further view of Moriya and Moon et al as applied to claim 12 above, and further in view of Armstrong et al (US 5,729,219 - filed Aug. 2, 1996 - issued March 17, 1998).

The Examiner has rejected claims 17 and 19 under 35 U.S.C. 103(a) as being unpatentable over Prior et al in further view of Moriya and Moon et al as applied to claim 12 above, and further in view of Kisaichi et al (US 5,786,776 -

filed March 12, 1996 - issued July 28, 1998).

Since the Final Rejection is similar to the first Office Action, only that the Examiner's arguments are now directed towards claim 12 as the base claim, the applicant will focus on the Response to Arguments for claims 12 and 17.

The Examiner states in the Response to Arguments that the applicant's primary argument over the prior art of Moon et al (US 6,211,858 B1 - issued April 3, 2001) with respect to claim 12 is that the mouse is used to make a menu selection choice, but Moon et al does not disclose -- said processing corresponding to a single—click or a double—click of a mouse--, as recited by claim 12. The applicant argued that this is evidenced by Moon et al, col. 5, lines 20-26, which discloses the following:

Another advantage of the portable intelligent communications device of the present invention is that its graphical user interface is designed to be operated by touch navigation, meaning that the human finger can be placed directly on the menu item choice of interest, which will have an identical effect as if a mouse or other pointing device were used to make the menu selection choice.

Therefore, the applicant maintained that since neither Prior et al nor Moriya nor Moon et al, taken alone or in combination, disclose, teach or suggest said processing corresponding to a single—click or a double—click of a mouse, as recited by claim 12, claim 12 patentably distinguishes over Prior et al in view of

Moriya and further in view of Moon et al.

The Examiner cites *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963) to assert that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art to patentably distinguish the claimed invention from the prior art. The Examiner asserts that if the prior art structure is capable of performing the intended use, then it meets the claim, and that in a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

With respect to the applicant's argument, the Examiner cites the same section of Moon as disclosing "the human finger can be placed directly on the menu item choice of interest, which will have an identical effect as if a mouse or other pointing device were used to make the menu selection choice."

The Examiner asserts that Moon is showing how pointing with a finger can be used to execute a function, just as a mouse (i.e., cursor) can be placed on an "OK" or "Cancel" button. The Examiner asserts that Moon, FIG. 7, and the corresponding discussion in column 7, lines 42-65, discloses that the actions are performed by touching a spot on the display and are analogous to a single or double click of a mouse. The Examiner as a result of his assertions is not persuaded by the applicant's argument that the references, when combined for the cited motivation, do not teach, recite or suggest the features disclosed.

In response, the applicant notes that the Examiner refers to In re Casey, page 238 [1], which the Court quotes In re Otto, which the applicant notes states the following:

“...It will be seen that the Lampert case pertains to the impropriety of relying on a method concept to distinguish a structural claim over the prior art and Rishoi and the others indicate that inclusion of the material or article worked upon by a structure being claimed does not impart patentability to the claims.”

The Examiner also cites Moon et al, column 7, lines 42-65, which the applicant notes states in part the following:

“Referring to FIG. 7, to add a fixed meter icon the user would ‘select’ one of the meters listed in the Select Meter box at 320, then press or touch (on a touch-screen display) the ‘Add’ button at reference numeral 342.”

In response, the applicant maintains that a mouse of a computer can perform several different functions, such as highlighting or scrolling, neither of which corresponds to a single click or double click of a mouse. Furthermore, a processor performing processing corresponding to a single-click or double-click of a mouse must, by necessity, entail a structural difference in the processor and not a method difference. Therefore, the court decisions in In re Otto and In re Casey are not apropos to the present invention recited by claim 12. In addition, Moon et al, neither in the portions cited by the Examiner nor anywhere else, never disclose,

teach or suggest said processing corresponding to a single—click or a double—click of a mouse, as recited by claim 12.

With respect to claim 17, the Examiner had objected to the use of the word “and” because this term indicates that all three limitations are included. In response, the applicant amended claim 17. The applicant maintained that the specification, page 18, lines 2-5, supports the current claim structure of claim 17 which includes all three limitations in the group.

With respect to the prior art rejection of claim 17, the applicant maintained that Kisaichi, column 28, line 61, to column 29, line 67, does not disclose, teach or suggest Japanese kanji characters. Since neither Prior et al nor Moriya nor Kisaichi et al, taken alone or in combination, disclose, teach or suggest a type of the hand-entered information or hand-written character entered through said touch panel includes at least one of (a) Japanese kana syllabary, (b) Japanese kanji, and (c) alphanumeric characters, claim 17 patentably distinguishes over Prior et al in view of Moriya and further in view of Kisaichi et al.

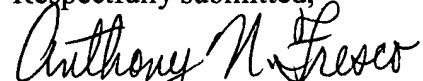
The Examiner cites 37 CFR 1.111(c) to assert that the applicant's arguments do not clearly point out the patentable novelty which the applicant thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The Examiner further asserts that the arguments do not show how the amendments avoid such references or objections.

The applicant interprets the Examiner's position as conceding that Kisaichi et al do not disclose Japanese kanji characters. The Examiner maintains that Kisaichi et al, column 28, line 61, disclose at least kana characters.

Consequently, in view of the applicant's arguments that claim 12 patentably distinguishes over the prior art, therefore, claims 9-11, 13-15, 17, and 19-20 also patentably distinguish over the prior art. As a result, the applicant respectfully requests that the Examiner withdraw the rejections of claims 9-15, 17 and 19-20.

Reconsideration of this application based on the foregoing Remarks is respectfully requested. The foregoing Remarks establish the patentable nature of all of the claims remaining in the application, i.e., claims 9-15, 17, and 19-20. No new matter has been added. Wherefore, early and favorable reconsideration and issuance of a Notice of Allowance are respectfully requested.

Respectfully submitted,


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